



UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/659,046	06/03/96	BAUER	

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QM22/0705

EXAMINER
DEXTER, L.

ART UNIT	PAPER NUMBER
3724	

DATE MAILED: 07/05/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

08/659,046

Applicant(s)

Bauer et al.

Examiner

Clark F. Dexter

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Apr 26, 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 13, 14, and 19-40 is/are pending in the application.
- 4a) Of the above, claim(s) 13 and 14 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 19-40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a) ☒ All b) ☐ Some* c) ☐ None of:

1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892) 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 20) ☐ Other: _____

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DETAILED ACTION

Continued Prosecution Application

1. The request filed on April 26, 2001 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 08/659,046 is acceptable and a CPA has been established. An action on the CPA follows.

Claim Objections

2. Claim 25 is objected to because it does not end in a period ".". Appropriate correction is required.

Claim Rejections - 35 USC § 112, 1st paragraph

3. Claims 21,22 and 40 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The original disclosure does not appear to provide support for the shearing elements of Figures 2a-c being beveled as now set forth in claims 21, 22 and 40.

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Claim Rejections - 35 USC § 112, 2nd paragraph

4. Claims 19-40 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 19, line 14, “configured to contact” is vague and indefinite as to how the first and second heads are “configured”.

In claim 20, line 2, “a cutting edge” is vague as to whether it refers to that set forth in claim 19 or to another such cutting edge.

In claim 21, line 1, “the at least one opposing face” lacks antecedent basis; in line 2, “beveled” is vague and indefinite since it is not clear as to how a face can be “beveled”.

In claim 22, line 1, “the other opposing face” lacks antecedent basis; in line 2, “beveled” is vague and indefinite since it is not clear as to how a face can be “beveled”.

In claim 24, line 1, “adapted to slide” is vague and indefinite as to how the back faces are “adapted”.

Claim 26 is vague and indefinite as to what structure is being set forth.

Claim 27 is vague and indefinite as to what structure is being set forth.

In claim 30, line 6, “a cutting element thereon” is vague and indefinite as to what disclosed structure is being set forth, particularly since the only cutting element disclosed is that formed by the slot and one of the faces; in line 12, “a cutting element thereon” is vague and indefinite as to what disclosed structure is being set forth; in line 16, “the cutting edges” lacks antecedent basis.

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Claim 35 is vague and indefinite as to what structure is being set forth.

Claim 36 is vague and indefinite as to what structure is being set forth.

In claim 38, the recitation "cutting edges" is vague and indefinite as to what disclosed structure it refers, particularly in view of the recitations of "cutting element" in claim 30.

In claim 39, it seems that "element" should be plural for clarity.

In claim 40, line 22, "configured to contact" is vague and indefinite as to how the cutting edges are "configured".

Claim Rejections - 35 USC § 102/103

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to

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point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103© and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 19, 20 and 23-39 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Merckens.

Merckens discloses a hand tool (e.g., in Figure 4) with every structural limitation of the claimed invention including a disc (e.g., at each end thereof) having opposing edges (e.g., 19) which are generally formed by a 90 degree intersection of two surfaces in the same manner as the present invention) formed by slot (e.g., formed by 19), and having a handle.

In the alternative, if it is argued that two of the tools are not disclosed, the Examiner takes Official notice that it is old and well known in the art to provide as many tools as necessary to perform a desired task or tasks. For example, it would have been obvious to one having ordinary skill in the art to provide two of Merckens' tools for various reasons including (1) having a second one as a backup in case a first one breaks or is lost, or (2) having a second one to provide to other users for performing other tasks. It is noted that the recitations directed to how the tools are used together (e.g., "said sides directly touching each other at said edges") has been given little patentable weight since it is clearly an intended use of the disclosed tools.

Regarding claims 28 and 37, further in the alternative, if it is argued that Merckens' tool does not disclose a disc because the term "disc" requires the head portion to be circular, and the head portion of Merckens is not circular, it is the Examiner's position that it would have been an obvious matter of design choice to one having ordinary skill in the art to make the head portions

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of the tool of Merckens circular since applicant has not stated that providing a circular head portion solves any stated problem or is for any particular purpose, and it appears that the device would perform equally well with a head portion of either shape.

8. Claims 19, 20 and 23-39 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Bussler.

Bussler discloses a hand tool with every structural limitation of the claimed invention including a disc (e.g., 5) having opposing edges (e.g., 3, 4 which are generally formed by a 90 degree intersection of two surfaces in the same manner as the present invention) formed by slot (e.g., formed by edges 3, 4), and having a handle (e.g., 2).

In the alternative, if it is argued that two of the tools are not disclosed, the Examiner takes Official notice that it is old and well known in the art to provide as many tools as necessary to perform a desired task or tasks. For example, it would have been obvious to one having ordinary skill in the art to provide two of Bussler's tools for various reasons including (1) having a second one as a backup in case a first one breaks or is lost, or (2) having a second one to provide to other users for performing other tasks. It is noted that the recitations directed to how the tools are used together (e.g., "said sides directly touching each other at said edges") has been given little patentable weight since it is clearly an intended use of the disclosed tools.

Further in the alternative, if it is argued that Bussler's tool does not disclose a disc because the term "disc" requires the head portion to be circular, and the head portion of Bussler is not circular, it is the Examiner's position that it would have been an obvious matter of design choice

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to one having ordinary skill in the art to make the head portions of the tool of Merckens circular since applicant has not stated that providing a circular head portion solves any stated problem or is for any particular purpose, and it appears that the device would perform equally well with a head portion of either shape.

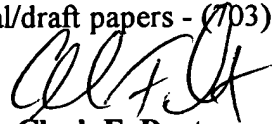
Allowable Subject Matter

9. Claims 21, 22 and 40 appear that they would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims. It is noted that these claims have been rejected as setting forth subject matter which is not sufficiently by the original disclosure.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Clark Dexter whose telephone number is (703) 308-1404.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Rinaldi Rada, can be reached at (703)308-2187.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703)308-1148. The fax numbers for this group are: formal papers - (703)305-3579; informal/draft papers - (703)305-9835.


Clark F. Dexter
Primary Examiner
Art Unit 3724

cfd
July 2, 2001